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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,689	05/08/2001	Steven Soloff	PD-201017A	3251

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THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
P O BOX 956
EL SEGUNDO, CA 90245-0956

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,689

Applicant(s)

SOLOFF, STEVEN

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2002-06-19</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/268,481, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In particular, the earlier filled application is silent with respect to the particular usage of a satellite broadcast system as claimed as well as tracking the particular duration or amount of time an individual watches a particular

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-22 and 25-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "traditional satellite broadcasts" in claims 1 and 12 is a relative term which renders the claims indefinite. The term "traditional" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention as it relates to "traditional". In particular, it is unclear as to whether any or all prior art satellite broadcast systems at the time of filing are to be interpreted as being traditional or if the scope is being limited to a particular sub-set satellite broadcasts. For example, is traditional to be considered as being limited with the broadcast format utilized by the assignee of the instant application? For the purpose of art evaluation, the examiner shall presume that "traditional satellite broadcasts" encompasses all prior art satellite broadcasts.

Claim Objections

4. Claim 11 is objected to because the term "said database file" lacks proper antecedence to claim 9. For the purpose of art evaluation, the examiner shall presume that the claim is referencing "a database file". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 8-17, 19-30, and 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Aras et al. (US Pat No. 5,872,558).

Claims 1 and 12 are rejected wherein Figure 1B of Aras et al. illustrates a system and method for “identifying and processing satellite based television usage and navigational data”. In particular the system comprises “means for generating promotional scenes . . . to be included in traditional satellite broadcasts” [101] (Col 6, Lines 45-54). These “promotional scenes” are subsequently received by a home station [111]. The home station comprises a “means for displaying said scenes on a viewing device located at a user location” [1563] (Col 24, Lines 29-43) and a subscriber monitoring program [1555] comprising a “means for determining when a user transitions from a first scene to a subsequent scene” (Figures 6C and 6D), a “means for identifying and recording the scene being viewed by the user and the time of day and duration of said viewing at the time of said user transition, thereby creating a navigational log record” (Figures 10-13; Col 15, Line 1 – Col 16, Line 33; Col 20, Lines 15-40), and a “means for storing said navigation log record in a memory storage device” [1706] (Col 16, Lines 34-51; Col 16, Line 60 – Col 17, Line 22).

Claim 23 is rejected in light of the rejection of claim 1 wherein Figure 1B of Aras et al. illustrates a “satellite-based communications network for identifying and processing satellite based television usage and navigational data”. Turning to Figure 1B, the system comprises a “broadcast center for broadcasting information” [123], “one or more communication satellites for receiving said broadcasting information” [115], “user receiving means situated within said satellite’s coverage area to receive said broadcast information” and a “viewing

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device connected to said user receiving means” [111]. The home station [111] comprises “video image selection means for providing a user with a means of transitioning from one scene to a subsequent scene, wherein said video image comprises said broadcast information” [1551] and “means for compiling user navigational data” [1555] (Col 24, Line 29 – Col 26, Line 32) wherein “said navigational data includes the identification of the scene being viewed, the time the user is viewing said scene, the length of time of said viewing, and the location of the user viewing said scene” (Figures 10-14; Col 17, Line 57 – Col 18, Line 9; Col 20, Lines 15-40).

Claim 25 is rejected wherein Aras et al. discloses a “computer program stored in a computer readable medium embodying instructions to perform a method of tracking satellite-based television usage characteristics” (Col 26, Line 33-41). In particular, the method comprises “determining when a user transitions from a first scene being displayed on a user’s viewing device, wherein said scenes comprise information included in traditional satellite television broadcasts” (Col 6, Lines 45-54; Col 24, Lines 29-43; Figures 6C and 6D), “identifying said scene being viewed by the user and the time of day and duration of said viewing at the time of said user transition, thereby creating a navigational log record” (Figures 10-13; Col 15, Line 1 – Col 16, Line 33; Col 20, Lines 15-40), and “storing said navigation log record in a memory storage device” [1706] (Col 16, Lines 34-51; Col 16, Line 60 – Col 17, Line 22).

Claims 2, 13, and 26 are rejected wherein the system further comprises “means for determining the geographical location of the user viewing said scene” (Col 12, Line 55 – Col 13, Line 23; Col 17, Lines 30-38).

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Claims 3, 14, and 27 are rejected wherein the “means for storing said navigational log record includes means for temporarily storing said log record in a temporary memory storage device” [1719] and “means for transmitting the contents of said temporary memory storage device to a permanent memory storage device” [1711] (Figure 17; Col 16, Lines 46-51; Col 26, Lines 1-20).

Claims 4, 15, and 28 are rejected wherein “said permanent memory storage device is comprised of FLASH memory” (Col 26, Lines 16-20).

Claims 5, 16, 24, and 29 are rejected wherein the system further comprises “means for periodically transmitting said navigational log record stored in said permanent memory storage device to a remote processing location” (Col 17, Lines 57-62; Col 26, Line 44 – Col 27, Line 8).

Claims 6, 17, and 30 are rejected wherein “said transmitting means is a modem” (Col 17, Lines 42-43).

Claims 8, 19, and 32 is rejected wherein the “means for temporarily storing said navigational log record includes means for determining if a scene’s navigational log record has already been recorded” (Col 16, Lines 17-21), “means for determining if the capacity of said permanent memory device has been reached, and means for reallocating, if necessary, an array of stored scene information to create space for an additional navigational log” (Col 14, Lines 25-53; Col 17, Lines 43-56).

Claims 9, 20, and 33 are rejected wherein “said means for transmitting the contents of said temporary memory storage device occurs at a predetermined time” (Col 16, Lines 46-51).

Claims 10, 21, and 34 are rejected wherein the “means for transmitting the contents of said temporary memory storage device includes means for opening an index and database file in said permanent memory storage device, means for determining a next available write location in said database file, and means for writing each entry in said navigational log record into said database file” in accordance with the buffering, processing, and storage of database records in the structured data array associated with non-volatile storage (Col 14, Lines 38-43).

Claims 11, 22, and 35 are rejected wherein the system further comprises “means for recording the latest recorded navigational log record into [a/said] database file even when the storage capacity of said permanent memory storage device has been attained”. In particular, the reference teaches that once the permanent memory storage device [1711] becomes full, it transmits its contents upstream and deletes the remaining records. Subsequently, the system continues processing/storing navigation records and is capable of “recording the latest recorded navigational log record” into the newly emptied/created database subsequent to the storage capacity of the permanent storage having been attained.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
9. Claims 7, 11, 18, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aras et al. (US Pat No. 5,872,558) in view of Laubach et al. (US Pat No. 5,870,134).

In consideration of claims 7, 18, and 31, as aforementioned, the Aras et al. reference discloses the particular usage of communication controller [1557] described as a cable modem or other device for communicating viewer behavior information upstream. The reference, however, does not particularly disclose that the cable modem or other device for upstream communication is necessarily a “traditional wireless data transfer means”. The Laubach et al. reference provides evidence as to a “traditional wireless data transfer means” or wireless cable modem that is utilized to transfer data upstream wirelessly (Col 2, Line 44 – Col 3, Line 6; Col 7, Lines 7-10). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to employ “traditional wireless data transfer means” as taught by Laubach et al. with the Aras et al. distribution architecture for the purpose of providing an efficient, transparent, and cost-effective approach for implementing two-way cable systems (Laubach et al.: Col 2, Lines 29-41) that

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further advantageously supports the upstream communication of monitoring information (Aras et al.: Col 2, Lines 52-56).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Aras et al. (US Pat No. 5,757,417) reference is explicitly incorporated by reference into the Aras ('558) reference and provides further details pertaining to the monitoring of materials presented to the subscriber including explicitly describing the BCT as a database file.
- The Brown (US Pat No. 5,857,190) reference discloses an event logging system for an interactive television network.
- The Ellis et al. (US Pub No. 2003/0005432) reference discloses a system and method for logging a user's interaction with interactive television applications.
- The Footer et al. (US 2002/0129373) reference discloses a system and method for obtaining data regarding customer usage of interactive television.
- The Ozer et al. (US Pat No. 6,704,929) reference discloses a system and method for tracking viewing behavior of a home entertainment system.
- The Ludtke (US Pat No. 6,202,210) reference discloses a data collection system for use in a home network.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott Beliveau
Examiner
Art Unit 2614

SEB
September 27, 2005